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PATENT  
Customer No. 22,852  
Attorney Docket No. 02860.0637-06000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Norikazu ARAI et al. ) Group Art Unit: 2653  
)  
Application No.: 10/743,110 ) Examiner: Kim-Kwok Chu  
)  
Filed: December 23, 2003 )  
)  
For: OPTICAL PICKUP APPARATUS, ) Confirmation No.: 2653  
RECORDING/REPRODUCING )  
APPARATUS PROVIDED WITH )  
THE OPTICAL PICKUP )  
APPARATUS, OPTICAL )  
ELEMENT, AND INFORMATION )  
RECORDING/REPRODUCING )  
METHOD )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY TO OFFICE ACTION**

This is a reply to the Office Action mailed on September 10, 2004, the period for response to which extends to December 10, 2004.

Attachments to this Reply include a copy of the Preliminary Amendment filed on December 23, 2003.

In the Office Action of September 10, 2004, the Examiner rejected claims 1, 7-10, 25, 26, 50, 62, 65, 68, 76, 77, 84-87, 102, 128, 134, 135, and 136 under 35 U.S.C. § 102(b) as anticipated by Katayama (U.S. Patent No. 5,696,750); rejected claims 13 and 90 under 35 U.S.C. § 103(a) as being unpatentable in view of Katayama and Yoo et al. (U.S. Patent 6,363,046); and rejected claims 14, 15, 19, 91, 92 and 96 under 35 U.S.C. § 103(a) as being unpatentable in view of Katayama et al. and Saito et al. (U.S. Patent No. 6,192,021). The Examiner objected to claims 113 and 114 as being dependent upon a rejected base claim, but stated that claims 113 and 114 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For the Examiner's convenience, a copy of the Preliminary Amendment filed on December 23, 2003 in this application is attached. No other preliminary amendment has been filed in this application. Pending claims 1, 77, 135, and 136 are independent.

Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

Applicants respectfully submit that Katayama fails to disclose each and every element of independent claims 1, 77, 135, and 136 and the claims depending from those claims. Claim 1, for example, recites an optical pickup apparatus comprising a first light source, a second light source, a converging optical system, and a photo detector.

Claim 1 recites, among other things, "in case that the first light flux passes through the first diffractive portion to generate at least one diffracted ray, an amount of first n-th ordered diffracted ray of the first light flux is greater than that of any other

ordered diffracted ray of the first light flux, and in case that the second light flux passes through the first diffractive portion to generate at least one diffracted ray, an amount of second n-th ordered diffracted ray of second light flux, where n stands for one integer other than zero”.

Claim 1 also recites “the converging optical system converges the first n-th ordered diffracted ray of the first light flux which passes through the first diffractive portion ... on the first information recording plane of the first optical information recording medium through the first transparent substrate so as to reproduce or record information from or onto the first optical information recording medium” and recites “the converging optical system converges the second n-th ordered diffracted ray of the second light flux which passes through the first diffractive portion on the second information recording plane of the second optical information recording medium through the second transparent substrate so as to reproduce or record information from or onto the second optical information recording medium”.

Thus, the same-ordered diffractive rays, other than 0-th order rays, are used for reproducing or recording information from or onto the different recording mediums.

Katayama discloses six embodiments in its description of preferred embodiments. However, in Katayama, as set forth in the Preliminary Amendment, different ordered light beams are used for the different disks or only the 0-th ordered light beam is used. Thus, for at least this reason, Katayama does not disclose or suggest all the elements of claim 1.

In regard to the 35 U.S.C. § 103(b) rejection, a *prima facie* case of obviousness has not been established because, among other things, none of the prior art cited by the

Examiner, nor their combination, teaches or suggests each and every feature of Applicants' claims.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 9, 2004

By:

  
Michael R. Kelly  
Reg. No. 33,921

**Attachments: Preliminary Amendment filed on December 23, 2003**